

TTAB



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shark Abrasion Systems Pty. Ltd.

Serial No.: 76/417,366

Mark: **SHARK**

Filed: May 31, 2002

Examining Attorney: William T. Verhosek

Law Office: 114

Attorney's Reference: 31848-181422

Hon. Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513



02-09-2004

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APPLICANT'S APPEAL BRIEF

INTRODUCTION

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based upon the section 2(d) of the Trademark Act.

THE RECORD

The record for this appeal consists of the application, a number of Office Actions and Responses, a Request for Reconsideration and the Examining Attorney's denial of the Request for Reconsideration.

THE EXAMINER'S POSITION

The Examining Attorney has maintained and made "Final" a refusal of registration based upon prior Registration Number 2,083,884 for the mark SHARK CHAIN for "chain comprised of digging bits for trenching machine."

THE APPLICANT'S POSITION

It is the Applicant's position that there is no confusion between Applicant's mark and Registrant's mark because the goods are sufficiently distinct and the marks are not identical.

ARGUMENT

A. Applicant's Mark and The Cited Mark Create Different Commercial Impressions

It is well-settled that in determining likelihood of confusion, the Examining Attorney must look at the marks in their entireties for similarities in appearance, sound, connotation and commercial impression. In re E.I. du Pont de Nemours & Co., F.2d 1357, 177 USPQ 563 (CCPA 1973). Here, that requires looking at the cited mark in its entirety. The cited mark is not identical to Applicant's mark and is readily distinguishable in appearance, sound, and commercial impression. See Kellogg Co. v. Pack'em Enterprises, Inc., 21 U.S.P.Q.2d 1142, 1144 (Fed. Cir. 1991) (finding that the mark FROOTEE ICE in script lettering and an elephant design and the mark FROOT LOOPS in plain capital letters sound differently and create different commercial impressions and the only similarity was that one began with the word FROOT and the other with the word FROOTEE). One mark is SHARK and the other mark is SHARK CHAIN.

Applicant's mark consists of the word SHARK, whereas, the registered mark consists of the terms SHARK and CHAIN. Registrant's mark must be considered as a composite mark and the word CHAIN must be considered as a part of the whole mark. See In re Burndy Corp., 133 U.S.P.Q. 196 (CCPA 1962) (finding that the letter 'B' in two design marks based on the letter B cannot be spoken and that neither mark is simply the letter 'B' but, rather, each is a composite of which the letter is but a part). Although the term CHAIN is disclaimed in Registrant's mark, a disclaimer does not remove the disclaimed matter from the mark. The marks must still be

regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. See TMEP § 1213.10. The combined mark SHARK CHAIN creates a different and distinct commercial impression such that customers would not be confused by these two marks.

B. Applicant's Mark and The Cited Marks Cover Unrelated Goods

Regardless of any similarities between Applicant's mark and the cited mark, the substantial differences between the respective goods are such that confusion is clearly not likely. It is well-settled that likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and cited registration. See e.g., Paula Payne Products, Co. v. Johnson Publishing Co., 177 USPQ 76 (CCPA 1973); In re Chalet Chocolates, Inc., 212 USPQ 968 (TTAB 1982); Ferdinand Mulhens v. Sir Edward Ltd., 214 USPQ 298 (TTAB) 1981; Ziebart International Corp. v. Northern Instruments Corp., 212 USPQ 537 (TTAB 1981).

The registrant's goods are "chain comprised of digging bits for trenching machine." The Examining Attorney's own evidence, submitted together with the denial of the Request for Reconsideration, indicates that trenching machines are relatively expensive pieces of equipment (costing approximately \$400,000.00), and that a trenching machine is "a giant ditch digger" which operates by rotating steel tracks around a large boom that resembles the blade of a chainsaw. In effect, trenching machines "use a heavy duty chain wrapped around a long movable boom." (See attached Exhibit "A"). The registrant's goods are "chains for trenching machines."

In contrast, the applicant's goods are

"Earthmoving equipment, namely, mechanical excavators and loaders; ground engaging tools for use with mechanical diggers and loaders, namely, shrouds, lips, adaptors and teeth."

The comparison here is between "earthmoving equipment" on the one hand, and "chains for trenching machines" on the other. This application does not cover trenching machines or chains for trenching machines, and the cited registration does not cover earthmoving equipment.

The goods of the parties are different on their face as well as different in practice.

In order to establish a relatedness of Applicant's goods and registrant's goods and services, the Examining Attorney has relied upon (a) the fact that there exist third-party registrations that allegedly show that there are third-party marks which cover both the applicant's goods and the registrant's goods; and (b) numerous internet printouts that purport to show the relatedness of the applicant's goods and the registrant's goods.

As indicated in Applicant's Request for Reconsideration, only four of the third-party registrations relied upon by the Examining Attorney even mention the term "chains" in the list of goods and services. Those are:

Registration No. 1,216,412 covers "machine parts-namely, pistons, liners, bearings, valves, radiator, turbocharger and injector parts for industrial diesel engines, cutting edges and end bits for ground engaging tools for earth moving and farming equipment, **chains** and sprockets for elevating scrapers and crawler tractor parts-namely, tracks, rollers, bearings, gearing, seals, and shafts for undercarriage and power train parts for earth moving vehicles"

Registration No. 2,120,921 covers "trencher **chains**, links teeth, teeth and bits"

Registration No. 2,121,924 covers "mining machines and machine tools, namely, road heading, drilling and tunneling machines, loading machines and carloaders, crushers, hydraulically powered mine roof supports; engines and electric motors for machines; machine couplings and transmission gears and belts; mineral winning machines, namely, earth augers; earth moving machines, namely, scrapers; conveyors and belt conveyors, namely, armoured face conveyors, scraper chain face conveyors, shaker conveyors, parts of such conveyors, namely, rollers, idler rollers, tension ends, scraper **chain** self loading tension ends, gate end loaders (belt and scraper chain); belt conveyor drives, and feeder breakers"

Registration No. 2,690,943 covers "Parts for agricultural tillage implements, namely-- bearings, seals, bearing standards, coulter blades, cultivator gauge wheels, disk blades, disk bushings, disk scrapers, disk spools, bolts, harrow teeth, hubs and caps, hydraulic cylinders and hoses, jacks, ripper points, spindles, sweeps, and wheels; Parts for agricultural seed planting implements, namely-- bearings, row units, coulter blades, down pressure springs, hydraulic cylinders, jacks, closing wheels, disk openers, gauge wheels, marker bearings, seed sensors, seed tubes, chains, and seed meters; Parts for agricultural hay implements, namely-- baler teeth, belts, round baler belts, bearings and seals, clutches, cutting sections, disk mowers, drivelines, feeder plunger bearings, filters, knives, lacers, lacing and pins, moisture testers, mufflers, rake teeth, rock guards, roller **chains**, seats, skid plates, wear plates, and windrower teeth; Parts for agricultural combine harvesters, namely-- alternators, starters, auger tubes, augers, axle extensions, axle spindles, bearings, seals, belts, brakes, chopper knives, clutches, concaves, corn heads, engines, feederhouse chains, drums and rollers, filters, hubs, hydraulic pumps, moisture testers, mufflers, platforms, pulleys, radiators, rasp bars, rotor impellers, seats, shafts, sprockets, turbochargers, sheaves, and water pumps."

Of these four third-party registrations, only two mention goods similar to Applicant's goods, i.e., Registration No. 1216412 and 2121924; however, even those registrations do not cover Registrant's specific type of chains, that is, "chain comprised of digging bits for trenching machines." Applicant's submits that this limited evidence does not establish that there is any relatedness between Applicant's goods and Registrant's goods, such that customers would be confused.

Even if these third-party registrations did have some probative value on the issue of likelihood of confusion, applicant respectfully suggests that the fact that allegedly similar goods may appear in a third-party registration is insufficient, in and of itself, to sustain a refusal of registration under Section 2(d) of the Trademark Act based upon a likelihood of confusion. See *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988)

The Examining Attorney has additionally submitted numerous articles purportedly evidencing a relationship between Applicant's goods and Registrant's goods. However, none of

the articles mentions both the applicant's goods and the registrant's goods in a context that would lead to the conclusion that such goods typically emanate from a common source.

Specifically, virtually all of the articles that purport to deal with the registrant's goods actually deal with "trenching machines" and, as a part of that discussion, they indicate that trenching machines operate by using a chain that runs on tracks around a boom.

Not a single article indicates that "earthmoving equipment" of the type offered by the applicant is in any way related to "chains for trenching machines" or that any of the goods covered in this application utilize "chains for trenching machines."

The massive amount of evidence produced by the Examining Attorney simply shows that certain words appear in the same articles on the internet or in the same patent. The evidence does not show that, as a result, there is a relationship between the applicant's goods and the registrant's goods.

The vast majority of the Examining Attorney's evidence attached to the denial of the Request for Reconsideration appears to be printouts of patents. It is respectfully submitted that the fact that there exist a number of patents in which the wording "trench! Machine" appears within 5 words of "excavator or loader or digger" in no way represents how real life consumers would encounter either the applicant's goods or the registrant's goods. It merely shows that in certain patents, certain words appear within a set number of words of one another.

Certainly, the fact that certain words appear within a set number of words of one another in a patent is not evidence of how goods are encountered in the marketplace. There is no evidence that consumers would be reading old patent documents when purchasing either the applicant's goods or the registrant's goods.

Applicant also submits that the mere fact that the goods in the cited registration and those goods listed in the instant application may, in the broadest sense of the term, be deemed "digging related" is insufficient to support a finding of likelihood of confusion. As the Trademark Trial and Appeal Board stated in General Electric Co. v. Graham Magnetics, Inc., 197 USPQ 690, 694 (TTAB 1977) "[i]t is, however, not enough to find one term that may generically describe the goods. More must be shown."

There is absolutely no evidence that the goods of the parties are in any other way related, or that they would even be encountered by the same consumers under such circumstances as would lead to a likelihood of confusion.

In Astra Pharmaceutical Prods. v. Beckman Instruments, 718 F.2d 1201, 1206, 220 USPQ 786, 790 (1st Cir.1983) the parties marketed and sold goods marked with the name "ASTRA" to the same purchasing institutions--large hospitals. 718 F.2d at 1206, 220 USPQ at 790. Although both parties manufactured goods "in the same broad health care field," *id.* at 1210, 220 USPQ at 793, Astra sold pharmaceutical products to hospital pharmacies and Beckman sold laboratory instrumentation to hospital laboratories. *Id.* at 1206, 220 USPQ at 790.

In affirming a grant of summary judgment of no infringement, the court held that use in the same broad field "is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." *Id.*, at 1206, 220 USPQ at 790. The First Circuit's holding recognized that "[t]he 'hospital community' is not a homogenous whole, but is composed of separate departments with diverse purchasing requirements, which, in effect, constitute different markets for the parties' respective products." *Id.* at 1207, 220 USPQ at 791. Because a common purchasing agent for several autonomous departments "merely fills out the necessary forms and arranges the shipping details," *id.* at 1206, 220 USPQ at 790, even when there is an overlap in

purchasing persons due to a common purchasing agent, such an agent is not necessarily a "relevant person" for determining likelihood of confusion.

The same issues apply with respect to the present case.

The court in Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713, 21 U.S.P.Q.2d 1388 (CAFC 1992) agreed with the holding in *Astra*. In that case, the court held that

the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. *Astra*, 718 F.2d at 1206, 220 USPQ at 790. The likelihood of confusion must be shown to exist not in a purchasing institution, but in "a customer or purchaser." *Id.*, at 1206, 220 USPQ at 790. As one of our predecessor courts, the Court of Customs and Patent Appeals, stated in Witco Chem. Co. v. Whitfield Chem. Co., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *affg*, 153 USPQ 412 (TTAB 1967):

The court specifically indicated that it was "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal."

The court went on to find that

Although opposer's services and applicant's goods are purchased by some of the same large corporations, the individual departments therein may be as independent in their purchasing activities as were the hospital departments in *Astra*. In such corporations, it cannot be presumed, . . . that the general computer services are selected by the same individuals who select battery chargers and power supplies. There is no evidence here, for example, that those computer specialists in the administrative departments at General Motors responsible for purchasing computer services are also responsible for purchasing battery chargers for the auto parts and services departments.

In the present case, there is no evidence that the applicant's goods and the registrant's goods would even be purchased by the same consumers.

C. **Applicant's Mark and The Cited Marks Travel in Different Channels of Trade**

To support a Section 2(d) refusal of registration, it is necessary to show that the surrounding circumstances or marketing conditions of the parties goods are such that they would be encountered by the same persons under circumstances that would give rise to the mistaken belief that they have a common source. In re American Hoechst Corp., 19 USPQ 947, 947 (TTAB 1983); UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861, 879 (TTAB 1980); In re Whittaker Corp., 200 USPQ 54 (TTAB 1978); In re Mack, 197 USPQ 755, 756 (TTAB 1977); Mobay Chemical Co. v. The Standard Oil Co., 163 USPQ 230 (TTAB 1963). There is no evidence that the goods involved in this matter would be offered to the same customers.

The applicant offers "earthmoving equipment." These items are used to move massive amounts of earth.

The registration covers "chains for trenching machines." These chains are parts of trenching machines (not parts of earthmoving equipment) and, as such, are used in the trench digging process, not the earthmoving process.

In fact, it is apparent from the evidence of record that the channels of trade and customers are quite different for the Applicant and the Registrant.

Further, the goods of the applicant and those of the registrant are highly specialized and highly priced.

The Examining Attorney has not pointed to a single circumstance under which a consumer of the applicant's goods (earthmoving equipment) would encounter the registrant's

goods under such circumstances as would lead to confusion. That is because purchasers of the applicant's goods would not purchase the registrant's goods for use therewith.

The Examining Attorney has also not pointed to a single circumstance under which a consumer of the registrant's goods (chains for trenching machines) would encounter the applicant's goods under such circumstances as would lead to confusion. That is because purchasers of the registrant's goods are purchasing them specifically for use with trenching machines, and would not be purchasing them for use with any of the applicant's goods.

D. Conclusion

In this case, the marks are not identical, and the goods are not identical; but rather Applicant's mark and the cited mark are different, and the goods identified in this application and those listed in the cited registration are different. As such, these combined differences are sufficient to preclude a likelihood of confusion.

In order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely "possible." A higher standard is required. See Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient."). This burden has not been met in this case.

In view of the foregoing, it is respectfully requested that the refusal of registration be withdrawn

Respectfully submitted,

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Date: February 9, 2004

EXHIBIT A

HEADLINE: They know the drills Public works projects give equipment dealers a lift

BYLINE: Todd Meyers

BODY:

... computer technology and more.

"We've got everything for design firms and contractors," said Parsons.

"It's not a home show that the general public would be interested in."

Not unless they feel the need to drive home in a \$400,000 trenching

machine or a front-end loader.

Don Burr, a salesman with the St. Albans office of Vermeer, an Iowa-based manufacturer of rock trenchers and directional boring machines that move on tracks rather than wheels, never misses the

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January 29, 1997, Wednesday, FINAL EDITION

SECTION: LOCAL,

Pg. 1B

LENGTH: 670 words

HEADLINE: BLASTING BANS IGNITE QUEST;
DEVELOPERS SEARCH FOR WAYS TO BUILD WITHOUT EXPLOSIONS

BYLINE: JOHN MAINES; Staff Writer

DATeline: PEMBROKE PINES

BODY:

... feet of earth at Pembroke Pines' Summerchase development.

"Using trenchers this way is a first, as far as we know, in Florida," Winzeler said. "We've dug trenches before in Florida, and lakes in other states, but not here."

His trenching machines are giant ditch diggers. Using 500 and 750-horsepower engines, they rotate steel tracks around a large boom that resembles the blade of a chainsaw. Hydraulic pumps apply 2,500 pounds of pressure on the blade and the teeth cut slowly into the earth - down as far as

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Tennessee Manufacturer

September, 1996

SECTION: Vol 2; No 9; pg 1

LENGTH: 1329 words

HEADLINE: Astec Industrial Products creates Chattanooga addition

BYLINE: Kevin Kerfoot

DATELINE: Chattanooga; TN; US; South Central

BODY:

... aggregate into various mixes; and washing and conveying equipment. TelSmith markets its products individually and as complete systems, incorporating microprocessor-based automated controls for the efficient operation of its equipment.

Trencor designs, manufactures and markets chain and wheel trenching equipment, canal excavators, rock saws, roadminers and log handling equipment.

Trencor chain trenching machines use a heavy duty chain wrapped around a long movable boom. These machines, with weights up to 400,000 pounds, are capable of cutting a trench up to eight feet wide and 30 feet deep. Trencor also makes foundation ...

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SECTION: LOCAL, Pg. 17C